

REMARKS

The present application includes pending claims 1-22, all of which have been rejected. Claims 1-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,278,449 (Sugiarto) in view of United States Patent No. 6,430,624 (Jamtgaard) and United States Patent No. 5,481,710 (Keane). The Applicants respectfully traverse this rejection, at least for the reason discussed below and previously during prosecution.

I. The Combination Of Sugiarto, Jamtgaard, And Keane Does Not Teach Each And Every Limitation Recited In The Claims

A. Sugiarto Does Not Teach, Nor Suggest, "Recording User Actions For Arranging The Elements On The Source Page And The Template Page"

In response to the Applicants' assertion that Sugiarto does not teach or suggest recording user actions for arranging the elements on the source page and the template page, the Office Action states the following:

The examiner respectfully disagrees with the Applicant and believes Sugiarto clearly teaches recording user actions (i.e. user manipulation of elements on the source pages and the template page) (column 6, lines 10-40 & columns 7-8, lines 55-30) (Fig.3).

June 3, 2005 Office Action at page 7.

The Applicants respectfully maintain, however, that Sugiarto does not teach, nor suggest, "recording user actions for arranging the elements on the source page and the template page." Instead, Sugiarto merely saves portions of websites onto a particular screen such that a user can configure a home screen that will display information from websites of interest. For example, Sugiarto states the following:

Thus, in this manner, a user **may select various portions of one or**

more websites to be included in the target screen 570....

Finally, a user may save an edited configuration file by selecting save button 525, may exit the configuration screen and return to personal administration page 205a by selecting done button 530, and may obtain help by selecting help button 414.

Sugiarto at column 6, lines 22-33 (emphasis added).

As noted above, Sugiarto discloses a system in which a user can configure a customized, personalized screen that includes relevant portions of websites of interest. Again, Sugiarto merely discloses saving portions of websites onto a particular screen such that a user can configure a home screen that will display information from websites of interest, but does not teach or suggest “recording user actions for arranging the elements on the source page and the template page.” While a user may “manipulate” a portion of a website to be saved, Sugiarto does not teach or suggest that the various user actions are “recorded for arranging elements on the source page and the template page.” Sugiarto does not teach or suggest recording user actions, such as in two stacks, which serve as the basis for supporting unlimited redo/undo tasks. Instead, as clearly shown above, Sugiarto merely describes saving portions of different websites onto a particular screen. There is nothing in the portions of Sugiarto that the Office Action relies on (i.e., column 6, lines 10-40, and column 7, line 55 to column 8, line 30) that teach or suggest “recording user actions for arranging the elements on the source page and the template page,” in order to support unlimited redo/undo tasks. If the Examiner maintains the position that Sugiarto discloses this limitation, the Applicants respectfully request quotations of actual text from Sugiarto that supposedly disclose this limitation.

B. Sugiarto Does Not Teach, Nor Suggest, “Generating The Set Of Transform Rules For the Source Page According To The Source Page URL”

The Office Action maintains that column 5, lines 61-63 of Sugiarto discloses “generating the set of transform rules for the source page according to the source page URL.” *See* June 3, 2005 Office Action at page 7. The cited portion of Sugiarto recites the following:

In web page editing screen 500, a user enters a website address in a URL portion 515, and then selects the submit button in order to access the website for use.

See Sugiarto at column 5, lines 61-63. This passage, however, merely discloses a way of gaining access to a website. That is, as clearly noted above, a user may type in a URL address to gain access to a particular website. The Office Action has not explained how merely gaining access to a website equates to “generating the set of transform rules for the source page according to the source page URL.” Again, the Applicants respectfully submit that gaining access to a website by typing in a URL address is not “generating a set of transform rules for the source page according to the source page URL.”

Sugiarto goes on to state the following:

This request is then transmitted from desktop computer system 9, through internet network 4 to system server 2 as shown in FIG. 1. System server 2 then retransmits this request back to internet network 4, and accesses the requested web page. In addition to identifying a web page at URL portion 515, a user may select a particular web page from bookmark section 550.

Id. at column 5, line 63 to column 6, line 3. In short, Sugiarto merely discloses a method of gaining access to a webpage, namely, typing in a URL address. Sugiarto, however, does not

teach, nor suggest, “generating the set of transform rules for the source page according to the source page URL....” The combination cited by the Examiner does not teach, nor suggest, this limitation. Thus, at least for this reason, the claims of the present application should be in condition for allowance.

C. Jamtgaard Does Not Teach, Nor Suggest, “Generating The Set Of Transform Rules For The Source Page According To... The XSLT”

The Office Action cites Jamtgaard column 2, lines 12-17 to overcome Sugiarto’s lack of “generating XSLT from the generated chains and thus generating the transform rules in part from the XSLT.” The cited passage of Jamtgaard states the following:

Comparable languages, such as Extensible Markup Language (XML), a software language designed especially for Web documents, have become much more mature and permit re-formatting of HTML or XML web pages on-the-fly to formats that individual devices can utilize.

Jamtgaard, column 2, lines 12-17. This passage merely states that XML permits formatting of HTML or XML web pages to different formats. It does not, however, teach or suggest “generating the set of transform rules for the source page according to... the XSLT.” Further, as noted above, the Office Action admits that “Sugiarto does not teach generating XSLT from the generated chains and thus generating the transform rules in part from the XSLT.” June 3, 2005 Office Action at page 3. The Applicants respectfully submit that neither Sugiarto, nor Jamtgaard, teach or suggest “generating the set of transform rules for the source page according to... the XSLT,” as recited in claim 1 of the present application. Thus, at least for this reason, the Applicants respectfully submit that the claims of the present application should be in condition for allowance.

II. One Having Ordinary Skill In The Art Would Not Be Motivated To Combine The References

“A prior art references **must** be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” MPEP at 2141.02. The Applicants respectfully submit that the attempt to pick and choose isolated elements from Jamtgaard and Keane and shoehorn them into Sugiarto ignores the references in their entireties and is therefore improper. There simply is no suggestion in these references to combine them to arrive at the invention recited in the claims of the present application. For example, there simply is no teaching or suggestion in Sugiarto to combine it with Keane to arrive at “recording user actions onto at least two stacks,” and “using the at least two stacks as the basis for supporting the user actions.” Even if one assumed that the combination did teach the limitations recited in the claims, there simply is no motivation to combine these references found within these references.

“In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is **not** whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP at 2141.02. The law is well settled that “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so.” *ACS Hospital Systems, Inc. v. Montfiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929 (Fed. Cir. 1984). It is not permissible to pick and choose among the individual elements of assorted prior art references to re-create the claimed invention, but rather “some teaching or suggestion in the references to support their use in the particular claimed combination” is needed. *Symbol Technologies, Inc. v. Opticon, Inc.* 935 F.2d 1569, 1576, 19 USPQ2d 1241 (Fed. Cir. 1991).

In *Ex parte Hiyamazi*, the Board of Patent Appeals and Interferences reversed a rejection

based on a combination of references, stating, in part:

Under 35 USC § 103, where the Examiner has relied upon the teachings of several references, the test is whether or not the reference viewed individually and collectively would have suggested the claimed invention to the person possessing ordinary skill in the art. Note *In re Kaslow*, 707 F.2d 1366, 107 USPQ 1089 (Fed.Cir. 1983). It is to be noted, however, that citing references which merely indicate the isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed references would have been obvious. That is to say, there should be something in the prior art or a convincing line of reasoning in the answer suggesting the desirability of combining the claimed invention. Note *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed.Cir. 1986).

Ex parte Hiyamazi, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Interf. 1988).

In combining Sugiarto, Jamtgaard, and Keane, the Office Action has merely picked and chosen among isolated, individual elements of separate references to re-create the Applicants' claimed invention. In short, the Applicants respectfully submit that the Office Action uses the claims of the present application to provide the motivation to combine these references, as the motivation to combine is not contained within the references themselves. There is no teaching or suggestion in these references to support their use in the particular claimed combination. The proposed combination represents "the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed.Cir. 1983). Thus, at least for these reasons, the Applicants respectfully submit that the claims of the present application should be in

condition for allowance.

III. Traversal Of Perceived Assertion Of Official Notice

In response to the Applicants traversal of the Office Action's perceived assertion of Official Notice, the Office Action merely cites examples of single keystroke copy, paste and cut. June 3, 2005 Office Action at page 9 The Office Action, however, does not explain how each the examples in the attached Microsoft Word document are necessarily performed with **a single user action** including a keystroke. While, the Office Action shows cutting and pasting, the Office Action does not explain how this is performed with **one** user action. For example, while page 4 of the cited Microsoft document shows a "source element" moved to a different position, there is nothing in the screen shot to lead one to believe that such movement was carried out by **one** user action including a keystroke. Thus, the Applicants respectfully maintain the traversal of the perceived assertion of Official Notice and submit that the subject matter is not of such "notorious character" that it is "capable of instant and unquestionable demonstration as being well-known."

IV. Correspondence Address

The Applicants note that the June 3, 2005 Office Action was sent to the wrong address. The Applicants refer the Examiner to the Combined Declaration and Power of Attorney filed with the Office on September 5, 2001, which recites that all correspondence should be addressed to the following:

McAndrews, Held & Malloy Ltd.
500 W. Madison St., 34th Floor
Chicago, IL 60661

V. Conclusion

In view of the foregoing, it is respectfully submitted that the pending claims of the present application define allowable subject matter. The Applicants respectfully request reconsideration of the claim rejections. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the telephone number listed below. Please charge any additional fees or credit overpayment to Applicants' Deposit Account 13-0017.

Respectfully submitted,

Date: July 8, 2005

By: 

Joseph M. Butscher
Reg. No. 48,326
Attorney for Applicants

McANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312) 775 - 8100